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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,856	02/11/2002	Hiroshi Yaginuma	SHG-0205; 85439-0205	8968
	7590	04/01/2004	EXAMINER	
David T. Nikaido RADAR, FISHMAN & GRAUER, PLLC Suite 501 1233 20th Street, NW Washington, DC 20036			HENDRICKSON, STUART L	
			ART UNIT	PAPER NUMBER
			1754	
DATE MAILED: 04/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10068856

Applicant(s)

Yagmurs

Examiner

R. Dickson

Group Art Unit

1154

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 3/5/04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-15, 18-21 is/are pending in the application.
- Of the above claim(s) 19-21 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) ~~1-15, 18~~ 1-2, 9-15, 18 is/are rejected.
- ☒ Claim(s) 8 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1754

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Newly submitted claims 19-21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-15, 18 drawn to making a carbide, classified in class 423, subclass 440.
- II. Claims 19-21, drawn to a composition, classified in class 75, subclass 236.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the carbide product can be used as an abrasive or hardness-article by itself.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) In claim 10, 'a nitrogen gas' and 'a' CO gas are unclear.

Claims 15 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kimmel et al.

Kimmel teaches W carbide, but not the N and O levels. Due to the similarity of the synthesis, it is expected that their product has the claimed impurities.

Claims 15, 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP '900.

The reference teaches in the example a similar synthesis, having only 1 carbon addition step. No differences are seen in the product, due to the similarity of the process.

Claims 1-7, 9-15, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martorana.

The reference teaches mixing tungstate solution and carbon colloid, then adding carbon to reduce the remaining W oxide to W carbide. Using the claimed solution concentration, if not possessed, is an obvious expedient to form a colloid, and purity is an obvious expedient to make the desired pure product. These features represent routine optimizations; In re Boesch 205 USPQ 215. the reference does not require the second carbon addition, however performing it is an obvious expedient to convert all the oxide to carbide. The overlapping temperature renders claims 11-14 unpatentable.

Applicant's arguments filed 3/5/04 have been fully considered but they are not persuasive.

The effort is appreciated, however the computer translations are of little value. It is axiomatic that using pure reagents yields a pure product- at commensurate greater expense but yielding a more valuable product.

Claim 8 is deemed allowable due to the high resulting free C content, contrary to the teachings of the prior art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.



Stuart Hendrickson  
examiner Art Unit 1754